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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,467	12/12/2003	Veronique Ferrari	244818US0	8836
22850	7590	07/09/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
VENKAT, JYOTHSNA A				
ART UNIT		PAPER NUMBER		
1619				
NOTIFICATION DATE		DELIVERY MODE		
07/09/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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### Office Action Summary

**Application No.**

10/733,467

**Applicant(s)**

FERRARI ET AL.

**Examiner**

JYOTHSNA A. VENKAT

**Art Unit**

1619

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date 5/27/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are

74,75,78,79,81,83,85,87,88,90,91,93,94,96,98,99,102,103,105,107,109,111,112,114,115,117,118,120,122,123,125-127,129,131,133,135-139,141,142,144 and 146-160.

Continuation of Disposition of Claims: Claims rejected are

74,75,78,79,81,83,85,87,88,90,91,93,94,96,98,99,102,103,105,107,109,111,112,114,115,117,118,120,122,123,125-127,129,131,133,135-139,141,142,144 and 146-160.

### **DETAILED ACTION**

Receipt is acknowledged of amendment, remarks and declaration filed on 4/17/09 and IDS filed on 5/27/09. Claims 77, 89, 101, 113, 125 and 137 have been canceled and claims 154-160 have been added as per applicants' amendment dated 4/17/09.

#### **Status of claims**

**Claims 1-73, 76, 80, 82, 84, 86,89, 92, 95, 97, 100-101, 104, 106, 108, 110, 113, 116, 119, 121, 124-125, 128, 130, 132, 134,137, 140, 143, and 145 are cancelled.**

Claims 74, 75, 78-79, 81, 83, 85, 87-88, 90-91, 93-94, 96, 98-99,102-103,105,107, 109,111-112, 114-115, 117-118, 120, 122-123, 125-127, 129,131,133,135-139, 141-142,144 and 146-160 are currently pending.

In view of the declaration and instant specification describing under examples Nylon-611 /dimethicone copolymer and in view of parent application 10/166, 762 describing the claimed formula and also siloxy silicate and silsesquioxane, the new matter rejection is hereby withdrawn.

WO 03/013,447 is a competent reference based upon its effective filing date, which is 8/7/01.

#### ***Claim Rejections - 35 USC § 103***

Claims 74, 75, 78-79, 81, 83, 85, 87-88, 90-91, 93-94, 96, 98-99,102-103,105,107, 109,111-112, 114-115, 117-118, 120, 122-123, 125-127, 129,131,133,135-139, 141-142,144 and 146-160 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patent 5,837, 223 ('223) and WO 03/013,447 ('447).

Patent '223 teaches transfer resistant high luster cosmetic compositions and teaches at col.2, line 25 through col.3, line 17 claimed volatile solvent, which is isododecane and teaches claimed siloxy silicate polymer ( claimed silicone film forming agent,) at col.3, line 57 through col.4, line 17 and teaches at col.1, ll 11-17 pigments compositions for coloring the skin and lips and teaches under examples lipstick compositions. Patent at col.6, ll 13-22 teaches pigments and under examples teaches anhydrous lipsticks. The difference between the patent and the instant application is patent '223 does not teach claimed silicone polyamide copolymer.

However WO '447 teaches the claimed silicone copolymer in cosmetic compositions.

See formula A at page 3, see page 4, for DP, see paragraph [0014] for weight percent of silicone polyamide, see paragraphs [0015-0016] and [0019] for fatty phase, see paragraph [0032] for various formulations, see paragraph [0043] for waxes and see paragraph [0044] for claimed crystalline silicone compound, see paragraph [0046] for claimed pigments, see all the examples.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare transfer resistant compositions of patent '223 and add the silicone polyamide copolymer of WO document and use this polymer in various cosmetic formulations with the reasonable expectation of success that the silicone polyamide copolymers can be formulated into various cosmetic products and these cosmetic products are also transfer resistant in view of the silicone polyamide copolymers taught by WO '447 at page 2, [0006]. This is a prima facie case of obviousness.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 74, 75, 78-79, 81, 83, 85, 87-88, 90-91, 93-94, 96, 98-99, 102-103, 105, 107, 109, 111-112, 114-115, 117-118, 120, 122-123, 125-127, 129, 131, 133, 135-139, 141-142, 144 and 146-153 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,958,155 in view of U. S. Patent 5,837, 223 ('223).

Both the instant application and patent are claiming the same silicone polyamide copolymer in transfer resistant cosmetic compositions. Patent '155 is not claiming the claimed silicone resin as the film forming agent. Patent '223 teaches transfer resistant high luster cosmetic compositions and teaches at col.2, line 25 through col.3, line 17 claimed volatile solvent, which is isododecane and teaches claimed siloxy silicate polymer (claimed silicone film forming agent,) at col.3, line 57 through col.4, line 17 and teaches at col.1, ll 11-17 pigments compositions for coloring the skin and lips and teaches under examples lipstick compositions. Patent at col.6, ll 13-22 teaches pigments.

Accordingly it would be obvious to use the transfer resistant compositions of patent '155 and add the silicone film forming resin and volatile oil of patent '223.

It is prima facie obvious to combine two known compositions that have been used individually as transfer resistant with the reasonable expectation of success that the third composition also would be transfer resistant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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